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BLAKELY SOKOLOFF TAYLOR & ZAFMAN, LLP  
1279 OAKMEAD PARKWAY  
SUNNYVALE, CA 94085-4040

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**MAR 18 2009**

**OFFICE OF PETITIONS**

In re Application of :  
JJ Garcia-Luna-Aceves, et. al. :  
Application No. 09/845,088 : **DECISION ON PETITIONS**  
Filed: April 26, 2001 : **UNDER 37 CFR 1.78(a)(3) AND (a)(6)**  
Attorney Docket No. 5543P003 :

This is a decision on the renewed petitions under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6), filed September 29, 2008, to accept an unintentionally delayed claim under 35 U.S.C. §§ 120 and 119(e) for the benefit of the prior-filed applications set forth in the concurrently filed amendment.

The petition is **DISMISSED**.

A petition for acceptance of a claim for late priority under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000 and after the expiration of the period specified in 37 CFR §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii). In addition, the petition under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) must be accompanied by:

- (1) the reference required by 35 U.S.C. §§ 120 and 119(e) and 37 CFR §§ 1.78(a)(2)(i) and 1.78(a)(5)(i) of the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Director may require additional where there is a question whether the delay was unintentional.

The petition does not comply with item (1).

The amendment is not acceptable as drafted since it improperly incorporates by reference the prior-filed applications. An incorporation by reference statement added after an application's filing date is not effective because no new matter can be added to an application after its filing date (*see* 35 U.S.C. § 132(a)). If an incorporation by reference statement is included in an amendment to the specification to add a benefit claim under 35 U.S.C. § 120 after the filing date of the application, the amendment would not be proper. When a benefit claim under 35 U.S.C. § 120 is submitted after the filing of an application, the reference to the prior application cannot include an incorporation by reference statement of the prior application. *See Dart Industries v. Banner*, 636 F.2d 684, 207 USPQ 273 (C.A.D.C. 1980). *Note* MPEP §§ 201.06(c) and 608.04(b).

Before the petition under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) can be granted, a renewed petition and either an Application Data Sheet or substitute amendment (complying with the provisions of 37 CFR 1.121 and 37 CFR 1.76(b)(5)) to correct the above matters are required.

Since a renewed petition under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) does require an additional petition fee, the petition fee of \$1,410 submitted on September 29, 2008 will be refunded to petitioner's deposit account.

It is noted that a Request for Continued Examination under 37 CFR 1.114 and \$810 fee set forth in 37 CFR 1.17(e) has been timely paid on September 29, 2008. Accordingly, prosecution in this application has been reopened pursuant to 37 CFR 1.114.

This application is being referred to Technology Center Art Unit 2454 for further processing in accordance with this decision.

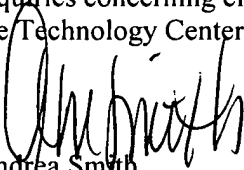
Further correspondence with respect to this decision should be addressed as follows:

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Any questions concerning this matter may be directed to the undersigned at (571) 272-3226. All other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center.

  
Andrea Smith  
Petitions Examiner  
Office of Petitions